REMARKS

In response to the Office Action dated 21 April 2004, the applicant requests reconsideration of the above-identified application in view of the following remarks. Claims 1-20 are pending in the application, and are rejected. Claims 6-9, 13-15, and 20 will be amended and new claims 21-32 will be added upon entry of the present amendment. No new matter has been added.

Amendment

Claims 6-8 will be amended upon entry of the present amendment to conform to the disclosure. Claims 9 and 20 will be amended upon entry of the present amendment to provide a proper antecedent basis for some claim elements. Claims 6-9 and 20 are not amended in response to the prior art rejection, and this is not a narrowing amendment. No new matter has been added.

New Claims

New claims 21-32 will be added upon entry of the present amendment. No new matter has been added.

Rejection of Claims Under §102

Claims 13-15 were rejected under 35 USC § 102(e) as being anticipated by Yoshimura et al. (U.S. 6,343,171, Yoshimura). The applicant respectfully traverses.

Yoshimura issued on 29 January 2002, which is less than one year before the 28 March 2002 filing date of the parent application. The applicant does not admit that Yoshimura is prior art, and reserves the right to swear behind Yoshimura at a later date. However, the applicant believes Yoshimura is distinguishable from the claimed invention.

Amended claim 13 recites an apparatus comprising, among other elements, means for receiving input optical signals.

Amended claim 13 is a means-plus-function claim under 35 U.S.C. § 112, paragraph 6.[1] The Examiner has not provided an explanation or a rationale as to why Yoshimura shows an equivalent to the corresponding elements disclosed in the specification.[2]

The applicant respectfully submits that Yoshimura does not show an equivalent to the corresponding elements disclosed in the specification under 35 U.S.C. § 112, paragraph 6. Yoshimura does not anticipate amended claim 13, and therefore amended claim 13 is in condition for allowance.

Amended claims 14 and 15 are dependent on amended claim 13, and recite further features with respect to amended claim 13. For reasons analogous to those stated above, and the features in the claims, the applicant respectfully submits that Yoshimura does not anticipate amended claims 14 and 15, and that amended claims 14 and 15 are in condition for allowance.

Rejection of Claims Under §103

Claims 1-12 and 16-20 were rejected under 35 USC § 103(a) as being unpatentable over Yoshimura in view of Tarui (JP-2003179402A). The applicant respectfully traverses.

The applicant respectfully submits that Tarui is not prior art under §102(e) or any other subsection of §102. The above-identified application is a divisional of U.S. Patent Application Serial No. 10/109,314, filed on 28 March 2002. Tarui is a publication of a Japanese application, published in Japanese. Tarui has a publication date of 27 June 2003 which is after the 28 March 2002 priority date of the above-identified application. For an international application to be applied under 35 USC § 102(e), it must have been published under PCT Article 21(2) in English.[3] Tarui is not such an application, and is not prior art.

Furthermore, there is no suggestion for a modification of Yoshimura. Yoshimura relates to opto-electronic substrates with electrical and optical interconnections.[4] The Office Action

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[1] MPEP 2181.
[2] MPEP 2182, 2183.
[3] MPEP 706.02(f)(1).
[4] Yoshimura, Title.

states that Yoshimura does not show capacitive DC shunt coupling.[5] The Office Action also states that:

> "it would have been obvious…to use DC shunt capacitors to couple motherboard to substrate. The motivation for doing so would have been to isolate the motherboard from the substrate, consistent with applicants background information disclosing the need for decoupling capacitors in order to increase the noise immunity of high-power circuits, such as CPU's."[6]

The MPEP requires a suggestion and a reasonable expectation of success for a rejection under 35 USC § 103:

> "To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations."[7]

The suggestion or motivation to combine references and the reasonable expectation of success must both be found in the prior art.[8]

The Office Action has not identified prior art as being the source of the quote above from the Office Action as is required by MPEP 2143. The Office Action has also not identified a reasonable expectation of success in the prior art as is required by MPEP 2143.

The applicant respectfully submits that a *prima facie* case of obviousness has not been established against claims 1-12 and 16-20, and that claims 1-12 and 16-20 are in condition for allowance.

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[5] Office Action, pages 3, 4, 5.
[6] Office Action, pages 3-4, 5.
[7] MPEP 2143.
[8] MPEP 2143.

CONCLUSION

The applicant respectfully submits that all of the pending claims are in condition for allowance, and such action is earnestly solicited. The Examiner is invited to telephone the below-signed attorney at 612-373-6973 to discuss any questions which may remain with respect to the present application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,

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By his Representatives,

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Date 20 JULY 2004

By _____
Robert E. Mates
Reg. No. 35,271

CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to: Mail Stop Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on this 20 day of ~~June~~ July (RE) 2004.

KACIA LEE
Name

Kacia Lee
Signature